

REMARKS

The above-outlined presentation of the claims and the following remarks are being submitted as a full and complete response to the Office Action mailed February 25, 2010. In view of the following remarks, the Examiner is respectfully requested to proceed with examination of the application on the merits, to indicate the allowability of the claims, and to pass this case to issue.

Restriction Requirement

In the restriction requirement, the Examiner has alleged that the claims in the present application are directed to more than a single, general inventive concept, in accordance with PCT Rule 13.1. In particular, the Examiner has identified four groups, Groups I-IV, as follows:

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| Group I | Claims 2-5, 8, 9, 16, 23 and 24, drawn to a method of treating an individual suffering from a cancer, comprising administering a therapeutically effective amount of an inhibitor comprising an antisense sequence. |
| Group II | Claims 2, 6-16 and 21-24, drawn to a method of treating an individual suffering from a cancer, and to a method of interfering with lengthening of telomeres and preventing or inhibiting the growth of a telomerase negative cell, comprising administering a therapeutically effective amount of an inhibitor comprising a nucleoside analog. |
| Group III | Claims 2, 8, 9, 16 and 23, drawn to a method of treating an individual suffering from a cancer, and to a method of interfering with lengthening of telomeres, comprising administering a therapeutically effective amount of an inhibitor comprising an inorganic compound. |
| Group IV | Claims 2, 8, 9, 16 and 23, drawn to a method of treating an individual suffering from a cancer, and to a method of interfering with lengthening of telomeres, comprising administering a therapeutically effective amount of an inhibitor comprising peptide. |

In response to the restriction requirement, Applicants respectfully provisionally elect Group II, claims 2, 6-16 and 22-24, with traverse, as will be discussed in detail to follow.

Further, in this Second Preliminary Amendment, Applicants have amended the claims to enhance clarity and to highlight the common special technical features present in all of the pending claims. Applicants respectfully submit that the claim amendments and newly added

claims 62-64 are fully supported by the specification as filed. Further, newly added claims 62-64 correspond to Group II and are, accordingly, elected for further prosecution.

Turning now to the restriction requirement in detail, the Examiner has alleged that the claims are directed to more than one invention, on page 2 of the Office Action. However, the Examiner has indicated that claim 1 is a generic linking claim to all four groups and that claim 16 is a linking claim to all four groups. In requiring the restriction, the Examiner alleged that the inventions of Group I-IV do not relate to a single, general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the reasons stated on page 2 of the Office Action. However, the Examiner merely concludes that “the different methods thereof lack unity of invention *a priori*.” The Examiner does not explain why the claims lack unity of invention and does not cite any prior art in support of such a conclusion.

Contrary to the statements in the Office Action, the inventions in pending claims 1-16, 22-24 and new claims 62-64 relate to a single, general inventive concept under PCT Rule 13.1. Applicants respectfully submit that each of the claimed inventions recites a number of commonly shared special technical features that define a contribution which, when considered as a whole, is novel over the prior art. For example, each of the claims requires the use of an inhibitor or antagonist of L-1 (LINE-1) retrotransposon encoded reverse transcriptase. The term “inhibitor or antagonist” is a defined term and refers to those that interact with L1RT to inhibit its expression or activity and/or those that get incorporated into a telomere, which thus prevents the telomere from further elongation, despite the functional L1RT, thereby inhibiting the growth of cells expressing L1RT. See the specification, for example, at page 7, lines 2-6 and page 8, lines 3-6. Thus, without regard to whether the inventions are claimed separately, the four identified groups of inventions are linked so as to form a single, general inventive concept.

Thus, while the Examiner relies on PCT Rule 13 in imposing the restriction requirement by a conclusory statement, the same rules invalidate the restriction requirement. Specifically, as discussed above, the inventions in claims 1-16, 22-24 and new claims 62-64 relate to a single, general inventive concept under PCT Rule 13.1.

In addition, Applicants respectfully submit that the subject matter of claims 1-16 and 22-24, and the newly presented claims 62-64, is sufficiently related so that a thorough search for the subject matter of one group of claims would necessarily encompass a search for the other

groups of claims. In addition, the International Searching Authority has already searched prior art with respect to the related claims (at least claims 1-9) in the corresponding International Stage of PCT application (PCT/US2005/001319). Therefore, there would be no undue burden to consider all claims in the present application.

Based on the foregoing, Applicants respectfully request the restriction requirement be withdrawn and all claims examined in the present application.

In addition to the restriction requirement, the claims were subjected to an election of species requirement. In response, Applicants provisionally elect ganciclovir, osteosarcoma and oral route of administration as species for further examination in the above-identified application, with traverse.

With respect to the election of species requirement, as with the restriction requirement, the Examiner likewise makes a conclusory assertion. In particular, the Examiner notes, at page 4 of the Office Action, that “[t]his application contains claims directed to more than one species of the generic method. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.” The Examiner provides a mere statement of conclusion.

Applicants respectfully submit that the conclusion is insufficient to support the election of species requirement. The Examiner, in order to establish reasons for insisting upon species election, must explain why there would be a serious burden on the Examiner if the species election is not required. The Examiner must show that there would be serious search burden, as evidenced by separate classification, status or field of search. In addition, the subject matter of the pending claims is sufficiently related so that a thorough search for the subject matter of one species would necessarily encompass a search for the other species in the group. Thus, there is no reason for insisting on the election of species and no undue burden on the Examiner. Further, for example, claims 7-8, 11-12 and 22-23 recite only a reasonable number of species. Thus, Applicants submit that all the claims and the claimed species can be searched and examined without any serious burden to the Examiner.

Furthermore, with regard to both the election of species and restriction requirements, Applicants respectfully submit that, in view of the fees charged for filing divisional patent applications and prosecution and maintenance of the resulting patents, in the event that the restriction requirement is not withdrawn, an undue burden would be placed upon the Applicants,

which justifies that any restriction or election requirement should be clearly supported and made according to the patent examining procedure.

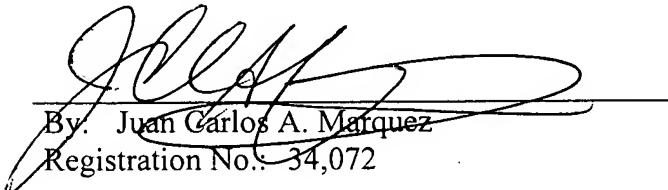
Finally, Applicants respectfully reserve the right to file, during the pendency of the present application, one or more divisional applications directed to the non-elected and/or canceled claims. Further, Applicants respectfully reserve the right to request rejoinder of any withdrawn claims should the restriction requirement and/or election of species requirement be maintained.

Conclusion

Favorable consideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and telephone number indicated below.

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